

Remarks

Reconsideration of the above-identified patent application is respectfully requested. Claims 20-40 are pending in this application. Of the claims, only claim 20 is independent.

Claim Rejections - 35 USC §103

Claims 20-37 and 40 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Atrens et al. (WO 9529207 A1) in view of Chiba et al. (US 5,447,561). Applicant respectfully requests reconsideration for the following reasons.

With respect to claim 20, it is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness. Applicants reiterate that the Examiner has not articulated a reason with some rational underpinning to support the conclusion that the recited claims are obvious over the cited references. An obviousness rejection cannot be sustained with mere conclusory statements. (See MPEP 706.02(j)(D); 2142.) The Examiner has merely provided a conclusory statement that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the cited references (see the March 31, 2009, Office Action, page 3, lines 12-16). Again, this conclusory statement is insufficient to establish a *prima facie* case of obviousness.

Further, Applicants respectfully submit that the Examiner has not followed the MPEP guidelines for determining obviousness. (See MPEP §2141, particularly III). Particularly, the Examiner has not clearly articulated some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Therefore, Applicant requests the Examiner withdraw the rejection.

Additionally, Applicant reiterates that in the Office Action response dated February 4, 2008, Applicant stated that the iron oxide and carbon as disclosed in Chiba et al. are not reactive to point out that one skilled in the art would not look to a pigment reference with non-reactive

components for reactive components for a patination material. Again, Applicant submits that the Examiner's response based on the inherent properties of the materials in the cited reference does not address the issue that the Examiner has not provided a clearly articulated rationale why the present invention is obvious over the cited references.

Applicant again respectfully points out that the Examiner's reliance on the inherency doctrine is unsupported. To establish inherency the Examiner has to provide extrinsic evidence that must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (MPEP §2112) However, the Examiner makes only a conclusory statement that the iron oxide and carbon of Chiba et al. would inherently be reactive if used as the recited oxidative agent and carbon (see March 31, 2008, Office Action, page 7, first full paragraph). Applicant again respectfully asserts that such a statement does not establish it is clear that the subject matter is necessarily present in Chiba et al., and that ordinary skilled artisans would recognize it. The Examiner's failure to provide such evidence is fatal to reliance on the inherency doctrine.

With respect to claims 21-37 and 40, these claims are dependent on claim 20. As Applicant has argued above, claim 20 is patentable over the cited references because the Examiner has failed to establish a *prima facie* case of obviousness, and it follows that its dependent claims are also patentable over these references.

Based on the foregoing, Applicant respectfully requests that the rejection of claims 20-37 and 40 be withdrawn.

Claims 38 and 39 are rejected under 35 U.S.C. §103 (a) as being unpatentable over Atrens et al (WO 9529207 A1) in view of Chiba et al. (US 5,447,561) as applied to claim 20 above and further in view of Priggmeyer et al. (US 6,176,905 B1).

Applicant respectfully asserts that the arguments made above regarding the Examiner's failure to establish a *prima facie* case of obviousness for claim 20 apply to this rejection as the

rejected claims are dependent on claim 20. Further, Applicant again respectfully submits the Examiner has incorrectly relied on the inherency doctrine and has failed to make a *prima facie* case of obviousness for claim 20. Nothing in Priggmeyer et al. overcomes these deficiencies of the Examiner's obviousness rejection. Because claim 20 is patentable, it follows that claims 38 and 39 are also patentable. Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

Conclusion

It is believed that Applicant has responded fully to all of the issues raised by the Examiner. Based on the above arguments and amendments, Applicant respectfully submits that claims 20-40 are allowable. Therefore, Applicant respectfully requests the Examiner to allow these claims.

If any fee is due, the Director is authorized to charge it to Deposit Account number 08-2442 of the undersigned.

Respectfully submitted,
HODGSON RUSS LLP
Attorneys for Applicant(s)

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By: /rachel s. watt#46186/
Rachel S. Watt
Reg. No. 46,186

HODGSON RUSS LLP
The Guaranty Building
140 Pearl Street, Suite
Buffalo, New York 14202-4040
Tel: (716) 856-4000